REMARKS

I.   Introduction

Independent Claims 1, 65, 72, and 78 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed combination of U.S. Patent No. 5,893,105 to MacLennan and U.S. Patent No. 6,239,800 to Mayhew et al. Additionally, independent Claim 82 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed combination of "allClear," U.S. Patent No. 6,654,803 to Rochford et al., and U.S. Patent No. 5,697,788 to Otha. Applicants respectfully traverse these rejections for the reasons set forth below.

II.   35 U.S.C. § 103(a) Rejections Based on MacLennan and Mayhew et al.

Independent Claims 1, 65, 72, and 78 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed combination of MacLennan and Mayhew et al. Applicants respectfully traverse these rejections because one skilled in the art would not have been motivated to combine MacLennan and Mayhew et al. Further, even if MacLennan and Mayhew et al. were combined, the proposed combination would not yield all of the claim elements.

A.   No Motivation to Combine MacLennan and Mayhew et al.

1.   The Proffered Motivation in the Office Action Is Insufficient

In the Office Action, it was asserted that one skilled in the art would have been motivated to combine MacLennan and Mayhew et al. because using the "path highlighting" teaching of Mayhew et al. with MacLennan would "provide a quick way of notifying the user of which cells are in the path." Applicants respectfully submit that this result is not achievable by the proposed combination of MacLennan and Mayhew et al. Accordingly, the motivation set forth in the Office Action is insufficient to support the 35 U.S.C. § 103(a) rejections.

Mayhew et al. teaches the use of a flow chart as a "to-do" list for complex software installation. In Mayhew et al., the flow chart is a series of icons that are displayed to a user, where each icon represents a job to be performed in the installation process. The icons are arranged in the order in which the jobs must be performed for a successful installation. To run a job, the user selects an icon, activates a pull-down menu, and then selects a "run" option. When the job is completed, the icon is shaded or otherwise displayed differently, so that the user is able to quickly determine which jobs are left to do by glancing at the flow chart.

It is important to note that Mayhew et al. does not "determine a path" when an icon is selected — it merely shades the icon after the associated job is completed. Shading an icon (the purported "cell") after its associated job is completed does not require determining a path since the shading of the icon depends solely on that particular icon and not on other icons on the same or different path.[1] Accordingly, although the Office Action characterizes Mayhew et al. as teaching "*path* highlighting," Mayhew et al. is more accurately characterized as teaching "*cell* highlighting." Because Mayhew et al. only teaches "*cell* highlighting" and **_not_** "*path* highlighting," combining Mayhew et al. with MacLennan will not "provide a quick way of notifying the user of which cells are in the path," as asserted in the Office Action. Accordingly, the motivation set forth in the Office Action is insufficient to support the 35 U.S.C. § 103(a) rejections.

Applicants additionally note that similar cell-highlighting functionality is already present in MacLennan. As noted in the Office Action, MacLennan displays a dashed line around a "selected" cell in the flowchart. Since MacLennan already contains cell-highlighting

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[1] The Office Action asserted that col. 4, line 50 – col. 5, line 22 teaches determining a path. However, that passage merely teaches that, at the completion of a job, the associated icon is shaded or otherwise displayed differently, so that the user knows that the job is complete.

functionality, one skilled in the art would not have been motivated to combine Mayhew et al. with MacLennan as there is no motivation to add an already-existing feature to MacLennan.

In summary, because the motivation set forth in the Office Action is insufficient to support the 35 U.S.C. § 103(a) rejections and because there is no motivation to add an already-existing feature to MacLennan, one skilled in the art would not have been motivated to combine Mayhew et al. with MacLennan. Accordingly, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejections of independent Claims 1, 65, 72, and 78 and their dependent claims should be removed.

2.   Additional Motivation Deficiencies

There are additional reasons why one skilled in the art would not have been motivated to combine MacLennan and Mayhew et al. For example, in the Office Action, it was admitted that MacLennan does not teach receiving, *from a user*, a selection of a cell in the flowchart. According to the Office Action, the purported selection of a cell is performed by a processor when the flowchart is executed. The "selected" cell is indicated by a dashed line, which indicates that a particular cell is being executed. In this way, the dashed line is an indicator of the progress through the flowchart during flowchart execution.

Mayhew et al. teaches a user selecting an icon in a flow chart to perform a specific job in a complex software installation process, and this teaching was relied upon in an attempt to cure the admitted deficiency in MacLennan. However, one skilled in the art would not have been motivated to combine MacLennan and Mayhew et al. to cure this admitted deficiency because MacLennan teaches away from this modification. MacLennan specifically states that the "selected cell" is "an indicator of the progress of entity 60 through flowchart 26 during flowchart execution." Col. 3, lines 44-50. In this way, the processor "selects" the cell to show the user

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where the processor is in the execution of the flowchart. Under the proposed modification, instead of the processor selecting the cell to indicate which cell is being executed, the user would need to select the cell — essentially guessing which cell the processor is executing. This would be contrary to the basic operating principle of MacLennan. The basic operating principle of MacLennan is to provide a user with an indication of the progress of the processor along a flowchart. The proposed combination would completely remove this feature. Further, there is absolutely no reason why one skilled in the art would require a user to select a cell by guessing which cell the processor is executing. To use an analogy, the dashed line/"selected cell" in MacLennan is like a "you are here" dot on a map. In MacLennan, the dot is placed on the map by someone who knows where to put the dot. Under the proposed combination, the dot is placed on the map by someone who is lost.

In summary, because MacLennan teaches away from the proposed modification and because the proposed modification is contrary to the basic operating principle of MacLennan, Applicants respectfully submit that one skilled in the art would not have been motivated to modify MacLennan as proposed in the Office Action.

B. MacLennan and Mayhew et al. Fail to Yield All of the Claim Elements

Even if there were motivation to combine MacLennan and Mayhew et al., the proposed combination would fail to render the claims unpatentable because the proposed combination does not teach each and every element recited in the claims. For example, each of the claims recites the act of determining a path. It was admitted that MacLennan does not teach this act, and Mayhew et al. was relied upon in an attempt to cure the deficiency. However, as noted above, Mayhew et al. does not teach determining a path.

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In the Office Action, it was asserted that col. 4, line 50 – col. 5, line 22 of Mayhew et al. teaches determining a path. However, that passage merely teaches that, at the completion of a job, the associated icon is shaded or otherwise displayed differently, so that the user knows that the job is completed. There is no teaching of determining a path. Shading an icon (the purported "cell") after its associated job is completed does not require determining a path since the shading of the icon depends solely on that particular icon and not on other icons on the same or different path. Because Mayhew et al. does not teach "determining a path," it necessarily cannot cure the admitted deficiencies in MacLennan regarding the "determining a path" element.

III.   35 U.S.C. § 103(a) Rejections Based on allClear, Rochford et al., and Otha

Independent Claim 82 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed combination of allClear, Rochford et al., and Otha. Applicants respectfully traverse these rejections because Rochford et al. is not analogous art.

As stated in MPEP 2141.01(a), in order to rely on a reference as a basis for rejection, the reference must be in the field of Applicants' endeavor or be reasonably pertinent to the particular problem with which the inventors were concerned. The field of Applicants' endeavor is a flowchart with at least some cells that comprise instructions that are implemented by an application. In contrast, Rochford et al. is directed to a graphical user interface for displaying historical and current performance information for a route in a communications network. Rochford et al. is not in the field of Applicants' endeavor, as Rochford et al. does not relate to a flowchart with at least some cells that comprise instructions that are implemented by an application. Page ten of the Office Action admits the non-analogous nature of Rochford et al.: "[the proposed combination including Rochford et al.] fails to distinctly point out at least some of the cells in the flowchart comprising instructions that are implemented by an application."

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Rochford et al. is also not reasonably pertinent to the particular problem with which the

inventors were concerned. As indicated by the preamble of Claim 82, the problem with which

the inventors were concerned relates to building a flowchart along a single path. In contrast,

Rochford et al. relates to viewing historical and current performance information for a route in a

communications network. As such, Rochford et al. is not reasonably pertinent to the particular

problem of building a flowchart. One skilled in the art looking to build a flowchart along a

single path would not turn to a reference that displays historical and current performance

information for a route in a communications network because such a reference neither relates to

flowcharts nor to user-created cells with computer-executable instructions that are arranged along

a path.

In summary, because Rochford et al. is not analogous art, Applicants respectfully submit

that the 35 U.S.C. § 103(a) rejections of independent Claim 82 and its dependent claims should

be withdrawn.

IV.   Conclusion

In view of the foregoing remarks, Applicants submit that this application is in condition

for allowance.[2] Reconsideration is respectfully requested. It should be noted that while the

above remarks have focused only on certain elements of the independent claims, other elements

of the independent claims (and the dependent claims) provide additional grounds of patentability.

Applicants reserve the right to present arguments concerning these additional grounds and

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[2] In their previous Amendment, Applicants added certain elements to the independent claims in an attempt to expedite the prosecution of this application. Since the addition of those elements did not result in allowance of the claims and since the above arguments traversing the outstanding rejections do not rely upon those elements, Applicants have removed those elements from the independent claims and have placed them in new dependent claims. Because the prior rejections also attempted to improperly modify MacLennan to include receiving cell selection from a user and relied upon non-analogous art, the prior rejections should not be reinstated in view of these amendments.

additional reasons related to the lack of motivation to combine the references at a later time, if necessary.

If there are any questions concerning this Amendment, the Examiner is invited to contact the undersigned attorney at (312) 321-4719.

Dated: August 16, 2006   Respectfully submitted,
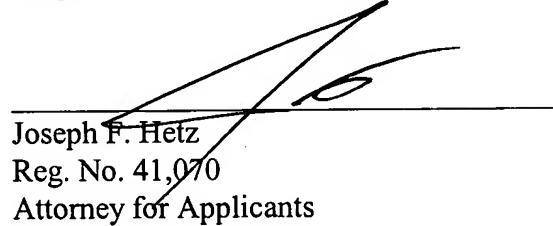
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Joseph F. Hetz
Reg. No. 41,070
Attorney for Applicants

BRINKS HOFER
   GILSON & LIONE
P.O. Box 10395
Chicago, Illinois 60610
(312) 321-4719